

REMARKS

In accordance with the foregoing, the specification has been amended. Claims 1-12 are pending and under consideration.

Claims 1, 4 and 9 are the independent claims.

The specification was amended to correct a typographical error and improve form.

No new matter is believed to have been added.

REJECTION UNDER 35 USC §112

Claim 3 stands rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. This rejection is respectfully traversed.

The Office Action contends that “searching among the sub-audio data streams of the another program for whether there is a sub-audio data stream having a channel ID which has a higher precedence than the precedence of the channel ID assigned to the sub-audio data stream of the program which was reproduced before the program was changed; and when the sub-audio data stream having the channel ID which has the higher precedence than the precedence of the channel ID assigned to the sub-audio data stream of the program which was reproduced before the program was changed exists in the another program, selecting, from the sub-audio data streams of the another program, the sub-audio data stream having the channel ID which has the higher precedence than the precedence of the channel ID assigned to the sub-audio data stream of the program which was reproduced before the program was changed” is not supported in further detail in the specification or claims and that this alleged failure renders the claims rejected under 35 U.S.C. § 112, first paragraph, non-enabled. This contention is respectfully traversed.

As a general matter, the requirements of 35 U.S.C. §112, first paragraph, are that the written description demonstrate to one of ordinary skill in the art that the inventor is in possession of the invention itself. MPEP 2163.02. Additionally, when evaluating compliance with 35 U.S.C. §112, the original written description being reviewed includes not only the specification, but also the claims and drawings as filed. MPEP 2163.06. Further, the mere fact that the words used in the claims are not used in the specification *in haec verba* by using the

same words does not necessarily mean that the specification does not describe the subject matter of the invention. MPEP 2163.02. As such, the requirements of 35 U.S.C. §112, first paragraph, are not that all details of an invention must be put forth in the written description using the same descriptive terminology, but instead whether the written description, including the claims as originally presented, provides sufficient details of the invention such that the disclosure reasonably conveys to one of ordinary skill in the art that the inventor had possession at the time of the later claimed subject matter.

Further, MPEP § 2164.06 provides that the Office has the initial burden to provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled. MPEP § 2163.04 requires evidence or reasoning for a written description rejection. It is respectfully submitted that the Office has not satisfied its burden because it has failed to do more than point to areas of the specification (i.e., page 6, lines 4-8 and pages 8-9 and FIGs. 1-6) and then state that further detail is not provided. The substantial recitations provided in the Action would indicate evidence of adequate enablement absent some compelling reason to doubt the sufficiency of the disclosure.

In addition the Applicant explains, at page 10, lines 3-13 of the originally filed specification that a higher order precedence channel is reproduced when changing programs without matching channels. In the example, either ID 3 or ID 1 is selected in the second program after ID 4 was used in the first program. As such, it is respectfully submitted that, due at least to this Example, and the other disclosure provided in the specification and claims that claim 3 is compliant with 35 U.S.C. §§112, first paragraph, and it is respectfully requested that the Examiner reconsider and withdraw the rejection.

DOUBLE PATENTING REJECTION

Claims 1-12 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of US Patent No. 6,694,091 and claims 1-12 of US Patent No. 6,813,281.

Since claims 1-12 of the instant application have not yet been indicated as allowable, it is believed that any submission of a Terminal Disclaimer or arguments as to the non-obvious nature of the claims would be premature. MPEP 804(I)(B). As such, it is respectfully requested that the applicant be allowed to address any obviousness-type double patenting issues remaining once the rejections of the claims under 35 U.S.C. §112 and §103 are resolved and

that the rejection be reconsidered in light of the amendments and claims presented above.

REJECTION UNDER 35 USC §103(a)

In the Office Action at pages 9-16, the Examiner rejects claims 1-12 under 35 U.S.C. §103(a) in view of Oguro (EP 0682421) and Endoh et al. (U.S. Patent No. 6,016,295). The rejections are respectfully traversed and reconsideration is requested.

Claim 1 recites "(a) when one of the programs is changed to another one of the programs, searching whether there is a sub-audio data stream having a channel ID which is the same as the channel ID assigned to the sub-audio data stream of the program which was being reproduced before the program was changed, in the another program; and (b) when it is determined that there is the sub-audio data stream having a channel ID which is the same as the channel ID assigned to the sub-audio data stream of the program which was being reproduced before the program was changed in the step (a), selecting the sub-audio data stream having the same channel ID of the another program."

Claim 4 recites "reproducing one of the dual mono channels of one of the audio data streams of a first one of the programs; changing to a second one of the programs; and determining if one of the dual mono channels of one of the audio data streams of the second program corresponds to the one dual mono channel of the one audio data stream of the first program, and reproducing the one dual mono channel of the one audio stream of the second program if the correspondence exists."

Claim 9 recites that "when a first one of the programs is changed to a second one of the programs, searching whether there is a second dual mono channel of the second program having a channel ID which is the same as a channel ID assigned to a first dual mono channel of the first program which was being reproduced prior to the change; and selecting the second dual mono channel if the search is successful."

In the Action at page 9, it is asserted that Oguro discloses a plurality of programs having at least two audio streams. The action seems to be equating the multilingual flag with the channel ID. However, as noted in the Action, Oguro does not disclose "selecting the sub-audio data stream having the same channel ID of the another program" as recited in claim 1. Further, there is no teaching or suggestion in Oguro that changing from one program to another initiates a search of sub audio data streams for a matching channel ID as recited in claim 1.

With respect to claim 4, Oguro does not teach or suggest "reproducing the one dual

mono channel of the one audio stream of the 'second program if the correspondence exists." Similarly, claim 9 recites selecting the channel ID if the search is successful. Oguro does not disclose such a search procedure when switching programs nor does Oguro disclose selecting a specific channel ID based on the results of the search.

Endoh does not cure the defects of Oguro. Endoh discloses a karaoke machine having bit stream information for determining a surround sound mode and special use mode according to a signal obtained by a mode sensor. (See Endoh Abstract). The machine has a default setting and then steps through stored language codes by one. (See Endoh col. 32, lines 53-67 and FIG. 59). However, no precedence is taken into consideration when stepping through the codes it is simply a sequential procession.

In contrast, claim 3 recites "searching among the sub-audio data streams of the another program for whether there is a sub-audio data stream having a channel ID which has a higher precedence than the precedence of the channel ID assigned to the sub-audio data stream of the program which was reproduced before the program was changed." The Action states that the default code is the same as the first program. (Action at page 10). However, comparing the default setting of the machine as taught by Endoh with a first program is not the same as switching from a first program to a second program as recited in claim 3. Further, Endoh does not teach or suggest that a search of the sub-audio data stream is executed for a channel ID with a higher precedence than the previously reproduced program (i.e., not just a default setting) as recited in claim 3. Rather, Endoh simply increments by 1 to another setting.

The default setting in Endoh is not equivalent to reproducing a first program as recited in claim 4. Similarly, switching from one program to another as recited in claim 1 and claim 9 is not taught or suggested by Endoh, which uses a default setting for comparison with a single program. For example, claim 12 depending from independent claim 9 recites "selecting a default one of the channels of the second program if the search is unsuccessful." Clearly the default setting of Endoh is not equivalent to the searching and selecting as recited in independent claim 9.

It is respectfully submitted that Oguro, either alone or in any proper combination with Endoh does not teach or suggest all of the limitations of independent claims 1, 4 and 9. Further, dependent claims 2-3, 5-8, and 10-12 are patentable over the references of record for at least the same reasons as their respective base claims, as well as for any additional features they recite.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

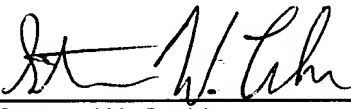
Applicant believes that the present Amendment is responsive to each of the points raised by the Examiner in the Official Action. However, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to such matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

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Date: 4/27/2005

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